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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,110	09/20/2000	KORBIN S. VAN DYKE	114596-26-0051BS	1446
38492	7590	12/28/2004	EXAMINER	
WILLKIE FARR & GALLAGHER LLP INTELLECTUAL PROPERTY LEGAL ASSISTANTS 787 SEVENTH AVE NEW YORK, NY 10019-6099			ELLIS, RICHARD L	
		ART UNIT	PAPER NUMBER	2183

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/666,110	VAN DYKE ET AL.
	<b>Examiner</b> Richard Ellis	<b>Art Unit</b> 2183

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b])**

- a)  The period for reply expires 3 months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The claim language changes presented would require a new search and further consideration..

3.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-72.

Claim(s) withdrawn from consideration: none.

8.  The drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.

9.  Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). \_\_\_\_\_.

10.  Other: See attachment.



RICHARD L. ELLIS  
PRIMARY EXAMINER

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Attachment to advisory action, paper number 20041220.

Applicant addresses several additional points in the now compliant amendment and as per current office policy, those points will be addressed at this time:

Point #1: That the fact that the previous advisory action did not address the entry/non-entry of the previous non-compliant amendment after final means that this amendment is allowed entry by right.

Applicant is in error in this assumption. Applicant's attention is drawn to an office policy memo from Stephen G. Kunin dated July 11, 2003, available to applicant at <http://www.uspto.gov/web/offices/com/sol/og/2003/week38/patamnd.htm> (copy attached).

Applicant's attention is drawn to the final sentence of the fourth paragraph of said memo, where it is stated in pertinent part the following:

"The Office will consider both the previous compliant amendment to the claims, and the supplemental compliant amendment to the claims, after the Office receives the compliant amendment to the drawings."

As is clearly indicated, a non-compliant amendment is not further treated until applicant corrects the reasons for non-compliance, and at that later point in time, the previous compliant portions, and the corrected compliant portion, will be treated on their respective merits.

Therefore, entry of this amendment is **not** allowed by right.

Point #2: That any refusal to enter this amendment based upon grounds present in the previous amendment would be improper piecemeal examination.

Applicant is also in error in this assumption. As seen above, the office policy is to treat non-compliant amendments upon their merits after applicant has corrected the reasons for non-compliance. Therefore no piecemeal examination can exist.

Point #3: That many US patent references cited on the IDS of July 2, 2004 were not indicated as considered, nor were objected to as not properly cited.

This was an omission on the part of the previous office action. Applicant's IDS submission states that:

"For non-patent items listed on the enclosed Form PTO-1449 for which a copy is not already made of record, a copy was previously cited by or submitted to ..."

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Applicant's submission made no reference as to where any US patent citations could be found, instead implying that the cited US patent documents should have been included. As MPEP 609 requires specific indication of where the omitted information may be found:

"There are exceptions to this requirement that a copy of the information must be provided. First, 37 CFR 1.98(d) states that a copy of any patent, publication, pending U.S. application, or other information listed in an information disclosure statement is not required to be provided if: (1) the information was previously cited by or submitted to, the Office in a prior application, provided that the prior application is properly identified in the IDS and is relied on for an earlier filing date under 35 U.S.C. 120; and (2) the IDS submitted in the earlier application complies with 37 CFR 1.98(a)-(c)." (MPEP 609)

As applicant's IDS documents only made reference to prior applications for the non-patent items, applicant failed to "properly identify" where the US patent references could be found and therefore failed to meet the rules for IDS submissions.

Point #4: That the lack of indication of consideration of the IDS is justification for withdrawal of finality.

Applicant is also in error as to this assumption. Applicant is reminded of the MPEP requirements for finality:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (MPEP 706.07(a))

As is clearly seen from the MPEP, all second actions **shall** (i.e., **must**) be final actions. Lack of consideration of an IDS is not an exception to this rule. Accordingly, the finality of the last office action was and is proper and there is no basis for withdrawal of finality.

Point #5: That the non-patent references that were not considered on the IDS of July 2, 2004 for failure to supply copies should have been considered because copies were provided and considered by the examiner in case 09/239,194 to which the IDS made reference.

After revisiting the IDS, it is determined that this was an oversight, and the pertinent non-patent references were cited, and are present, in case 09/239,194, from which this application depends for priority. Accordingly, corrected pages of the two pertinent IDS pages are included in this advisory action.



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PRIMARY EXAMINER